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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,105	12/29/2000	James M. Rogers	00139	6282
84326 7590 07/07/2011 AT & T LEGAL DEPARTMENT - Toler ATTN: PATENT DOCKETING ROOM 2A-207 ONE AT & T WAY BEDMINISTER, NJ 07921				
			EXAMINER	
			TAYLOR, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2426	
			MAIL DATE	DELIVERY MODE
			07/07/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/750,105

Applicant(s)

ROGERS ET AL.

Examiner

JOSHUA TAYLOR

Art Unit

2426

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,8,9,24,31-40 and 42-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8,9,24,31-40 and 42-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-3, 8, 9, 24, 31-40 and 42-46 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 28, 2011 has been entered.

Allowable Subject Matter

3. Claims 1-3, 8, 9, 24, 31-40 and 42-46 are in condition for allowance SAVE for the following conditions:

- All claims are rejected under double patenting.
- Claims 24, 31 and 33 are rejected under 35 U.S.C. 101.

If Applicant were to file a Terminal Disclaimer, and amend claims 24, 31 and 33 as suggested, this case will be in condition for allowance.

The reason that the case is allowable over the prior art of record is that none of the disclosed art or art found in Examiner's new search discloses wherein an advertising fee is higher for a local advertisement in the case where said local advertisement for a product or

service is inserted immediately after a national advertisement for the product or service, as opposed to said local advertisement being inserted at some other location in the program stream.

Therefore, it is the concept of charging higher fees based on the specific location of an advertisement relative to an associated second advertisement that Examiner finds to be novel. As an illustrative example, if an advertisement for an Atlanta Ford dealer (a local advertisement) were shown after an advertisement for Lays Potato Chips (an unrelated national advertisement), the Atlanta Ford dealer may be charged a \$10 fee for such placement. However, if the advertisement for the Atlanta Ford dealer (a local advertisement) were shown after an advertisement for a Ford F-150 (a related national advertisement; i.e. for the same product), the Atlanta Ford dealer may be charged a \$20 fee for such placement. This example is purely for illustrative purposes, and the ratios of the fees could be determined by the parties involved.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 24, 31 and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A “computer readable medium” is claimed, which can be interpreted as being a carrier wave, which is not one of the four patent eligible subject matter categories: process, machine, manufacture, or composition of matter. To overcome the 35 U.S.C. 101 rejection, Applicant could add the phrase “non-transitory” before “computer-readable medium.”

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 8, 9, 32, 34-40, 42 and 43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-28 of copending Application No.11/828,492. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are a method and a system for inserting advertisements into a stream of programming, wherein there are certain metrics for determining which advertisements will be selected. Although there are some differences in the specifics of the manner in which the selection is determined, the claims share a similar limitation concerning charging a different fee depending on whether or not an advertisement is placed near to another related advertisement; i.e. a local advertisement placed next to a national advertisement. Because this specific element is present in both of the claims, Examiner finds the claims to not be patentably distinct from one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Instant Application	Copending Application
1. A method comprising: receiving and storing at a media delivery device a plurality of targeted advertisements, wherein the plurality of targeted advertisements are selected for transmission to the media delivery device by a transmitting entity based on user data associated with the media delivery device; receiving and storing at the media delivery device data representing a set of characteristics associated with each of the	22. A system for inserting advertisements stored locally in a television set top box into a media programming stream, comprising: a receiver for receiving broadcast media programming into the set top box; a commercials database for storing advertisements in the set top box; a commercials detector for detecting audio tones in broadcast media programming where one or more of the detected audio tones are

<p>plurality of targeted advertisements; receiving a signal at the media delivery device authorizing insertion of an advertisement into a media delivery stream during broadcast media programming, wherein the signal is sent with the broadcast media programming, and wherein the signal includes selection data specifying an allowable type of the advertisement that is authorized to be inserted into the media delivery stream; identifying a set of allowable advertisements from among the plurality of targeted advertisements by searching the data representing the set of characteristics associated with each of the plurality of targeted advertisements using the selection data, wherein the set of allowable advertisements includes advertisements that are of the allowable type; selecting a particular advertisement from the set of allowable advertisements to be inserted into the media delivery stream by applying a weighting to at least one characteristic of each of the allowable advertisements of the set of allowable advertisements and comparing at least one weighted characteristic of each of the allowable advertisements; inserting the particular advertisement into a particular location in the media delivery stream identified by the signal; and identifying an advertising fee associated with insertion of the particular advertisement at the particular location in the media delivery stream identified by the signal, wherein the advertising fee is a first advertising fee when the particular advertisement is a local advertisement for a provider of a product or service that is inserted at a first location in the media delivery stream that follows a national advertisement for the product or service, and wherein the first advertising fee is higher than a second advertising fee that is associated with insertion of the local advertisement for the provider of the product or service at a second location in the media delivery stream.</p>	<p>substitution signals that indicate authorization for a local television station to insert a locally stored advertisement stored at the commercials database into the media programming stream, wherein the detected audio tones include information for selecting a particular stored advertisement that is to be inserted into the media programming stream; a commercials selector for selecting the particular locally stored advertisement to be inserted into the media programming stream, wherein one or more locally stored advertisements are identified based on the information included in the detected audio tones, wherein the particular locally stored advertisement selected for insertion into the media programming stream is determined at least in part based upon a frequency of insertion associated with each of the identified advertisements, and wherein at least one identified advertisement among the stored advertisements which has not been frequently inserted is favored over the remaining identified stored advertisements; switching logic to interrupt a television connected to the set top box from the media programming stream and to temporarily decode an advertisement stored in the commercials database when a substitution signal is detected by the commercials detector; and billing logic to generate billing information to be communicated to a network service provider, wherein the billing information identifies an advertising fee associated with insertion of the particular locally stored advertisement into a particular location in the media programming stream identified by the substitution signal, wherein a first advertising fee is identified when the particular locally stored advertisement is a local advertisement for a provider of a product or service that is inserted at a first location in the media programming stream that follows a national advertisement for the product or service, and wherein the first advertising fee is</p>
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	higher than a second advertising fee that is associated with insertion of the local advertisement for the provider of the product or service at a second location in the media programming stream.
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Further, claims 24, 31 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-28 of copending Application No.11/828,492, for the same reasons as stated above. Further, claims 44-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22-28 of copending Application No.11/828,492, for the same reasons as stated above.

Conclusion

6. Claims 1-3, 8, 9, 24, 31-40 and 42-46 are rejected.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571)270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Josh Taylor/
Examiner, Art Unit 2426
July 3, 2011